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IN THE
Supreme Court of the United States

October Term, 1948.

No.

RALPH E. JONES,

Petitioner,

vs.

SCHICK SERVICE, INC., and SCHICK, INC.,

Respondents.

BRIEF FOR RESPONDENTS.

This is a patent infringement case which arose upon the filing by petitioner Ralph E. Jones in the United States District Court for the Southern District of California of his Complaint charging infringement by respondents of his United States Letters Patent No. 2,228,768.¹ The District Court adjudged claims 22, 23, 31 and 32 thereof to be valid and infringed, while holding claims 1, 11, 17, 18, 19, 20, 24, 25, 26, 27, 28, 29 and 30 invalid [I R. 55].²

¹The Complaint also contained a count based upon an alleged oral contract of license; but both the District Court and the Court of Appeals have concurred in a judgment that this count must fail. No error has been assigned to this ruling, and hence this point is not before this Court (Rule 38(6)).

²The designation "I R. 55" indicates Volume I, page 55, of the printed record herein.

Both petitioner and respondents appealed to the Court of Appeals for the Ninth Circuit [I R. 78, 86]. The Court of Appeals filed an opinion [III R. 68] and rendered a decree adjudging that the cause be reversed in so far as it held valid claims 22, 23, 31 and 32 and affirming the decision of the District Court in so far as it held invalid the claims remaining in suit [III R. 590].

There has been no other adjudication of the patent in suit by any other court. It is therefore not claimed to involve a decision of courts of appeal in conflict upon the same matter which would justify the granting of certiorari by this Court within the first clause of Rule 38(5)(b). The record presents simply a case of a patent held partly valid and partly invalid by a District Court and totally invalid by a Court of Appeals.

Statement of the Case.

Petitioner seeks the grant of certiorari by this Court not because of any important question of Federal law which has not been, but should be, decided by this Court, or on any other ground for certiorari stated in Rule 38(b), but simply because of his dissatisfaction with the established practice in the appellate Federal courts in adjudging the invalidity of patents where invention is found to be lacking. This is admitted on page 21 of petitioner's Brief in Support of the Petition, wherein he states, "There is now ample precedent for the action of the Court of Appeals in this case * * *."

Petitioner's statement of the case at one point may leave a false impression of the facts. Respondents herein derived no ideas or inventions from petitioner's patent. Their accused devices and others like them were upon

the market in 1938 or 1939 [Testimony of Petitioner, I R. 231], several years before the granting of petitioner's patent on January 14, 1941 [II R. 424]. This patent was "independently discovered" by respondents after it issued [Petition of Jones, p. 3, lines 25-26]. The statement on page 4 of petitioner's Petition that respondents "incorporated the improvements claimed in the Jones patent in its dry shavers" after knowledge of Jones' alleged invention is erroneous.

Argument.

The only question presented by the petition is phrased by petitioner as follows [Petition, p. 7]:

"Is it permissible for any Court of Appeals to hold a patent invalid because it considers it was produced merely by the exercise of mechanical skill when in doing so it reverses a contrary Finding of Fact of the District Court, and it is the law of the case based on admissions by the defendant, that the District Court had before it no evidence of greater weight as to this question than that considered by the Patent Office?"

In reply respondents respectfully show the Court (a) that this question is not raised by the record; and (b) that, if raised by the record, this question has been conclusively determined by repeated decisions of this Court and other Federal courts for nearly one hundred years. There is therefore no occasion for this Court to concern itself with this case, and certiorari should not be granted.

Petitioner's "Question Raised" Is Not Presented by the Record.

Petitioner seeks to draw a special case, one in which a Court of Appeals reverses a judgment of the District Court as to validity of a patent where no evidence was presented which was not before the Patent Office. This question is not presented by the record herein.

The patent in suit involves a very simple concept; *i. e.*, that if the corners of an electric razor are rounded, they will not scratch.

The District Court held thirteen claims of this patent relating to the rounded corners invalid, filing an opinion that they did not "embody invention and are invalid because of indefiniteness" [I R. 412]. It held four claims which included the rounded corners in combination with hinges valid, though deeming that "It is a debatable question whether they embody invention" [I R. 412].

The Court of Appeals for the Ninth Circuit reversed this holding and found all claims in suit invalid. In so doing it specifically relied upon the prior patents to Bernard No. 765,954, Peterson No. 1,744,280 and Dean No. 2,014,882, which were not cited by the Patent Office [III R. 576, 580, 582]. It also adverted to the patents to Ventimiglia No. 1,801,889, Friedman No. 1,516,635 and Szabo No. 1,175,023, not cited by the Patent Office [See Footnote III R. 580]. The file wrapper of the patent in suit is presented in the record herewith as Physical Exhibit K. None of the above discussed prior patents were cited in this file wrapper.

It is apparent from the opinion of the Court of Appeals that the court attached greater weight to the newly cited prior art than to the prior art found by the Patent Office. The court specifically relied upon these newly cited prior patents in reaching its decision that the patent embodies "mere mechanical skill or knowledge" which possessed "no patentable quality" [III R. 577, 578].

At no time have respondents admitted, as suggested by petitioner,³ that these new patents were not of greater weight than those suggested by the Patent Office. Thus we find a situation where the District Court itself found the question of invention debatable and held the majority of the claims of the patent invalid for "want of invention and indefiniteness" and in which the District Court was reversed by the Court of Appeals in so far as it held four of the claims valid. The Court of Appeals made a different interpretation of prior art not cited by the Patent Office and held all of the claims invalid for want of invention. This surely does not raise the question proposed by petitioner.

³This admission is said to arise because respondents did not appeal from a sentence in Finding 14. This sentence comprises a mere conclusion of the trial court, and respondents' specification of errors was sufficient to bring that conclusion before the Court of Appeals.

The Question Proposed by Petitioner Has Been Decided Adversely to Him for One Hundred Years by Determinative Decisions of This Court.

It is fundamental law, since the decision of this Court in 1850 in the leading case of *Hotchkiss et al. v. Greenwood, et al.*, 11 How. 248, 265, 13 L.ed 683, 690, that a patent which does not display "more ingenuity or skill * * * than that possessed by an ordinary mechanic" is invalid for want of patentable invention.

The decision of the Court of Appeals in this case merely applied this rule.

Petitioner seeks to raise the question of what court can apply this doctrine and under what circumstances. He admits that there is "ample precedent for the action of the Court of Appeals in this case," but asks this Court to overrule these precedents. Apparently petitioner labors under the misapprehension that this Court has not applied the rule under identical circumstances.

We believe that we have shown above that there was ample evidence not considered by the Patent Office which justified the ruling of the Court of Appeals. However, if there were no such evidence, it would still be the duty of the court to hold the patent invalid if convinced that, in the light of the very same evidence before the Patent Office, there was still no invention above and beyond the skill of the mere mechanic displayed in the patent in suit.

This Court has itself acted accordingly on numerous occasions, and there is no occasion, as requested by petitioner, to redefine the law.

Thus, in *Marconi Wireless Telegraph Co. v. United States*, 320 U. S. 1, 87 L.ed. 1731, this Court reversed the lower court and held Marconi's patent in suit invalid in view of the Stone patent which was before the Patent Office.

Again, in *Keystone Driller Co. v. Northwest Engineering Corp.*, 294 U.S. 42, 79 L.ed. 747, the Clutter patent was held invalid by this Court in view of the prior Cross, Fairbanks and Rood patents which were also before the Patent Office (see the companion case decision in 44 F. 2d 283, 284).

Finally, attention is called to *Honolulu Oil Corp. v. Halliburton*, 306 U.S. 550, 83 L.ed. 980, wherein the Simmons patent was held invalid in view of the Franklin patent. This Franklin patent was not only before the Patent Office but also before the Board of Appeals of the Patent Office.⁴

Numerous other cases could be cited, but we think it is amply demonstrated that, where convinced of lack of invention, it is not only proper but the duty of an appellate court to hold a patent invalid, irrespective of whether there was or was not evidence in addition to that considered by the Patent Office.

⁴These facts are apparent from the file wrapper of the Simmons patent reproduced in the printed record in this Court.

Conclusion.

It is submitted that this case does not display any sufficient reason for the grant of a writ of certiorari within the rulings and practice of this Court. The purported "Question Raised" is not in fact raised by the record and, even if deemed raised, has long been answered by controlling rulings of this Court. Thus, no important question of Federal law remains to be decided by this Court.

Respectfully submitted,

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